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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,383	08/05/2003	Christopher P. Desmarais	60130-1776; 03MRA0273	8211
26096	7590	06/16/2006	EXAMINER	
CARLSON, GASKEY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009			KIM, SUN U	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,383

Applicant(s)

DESMARAIS, CHRISTOPHER P.

Examiner

Yoon-Young Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The amendment filed April 5, 2006 is rejected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the first wall unbounded by the second wall; the diverter extending along a longitudinal axis and the first wall offset radially from the longitudinal axis; and the hole outside of the second wall. The original disclosure is a side wall arranged opposite the cylindrical wall on the first side; a diverter arranged within the cavity and including first and second sides with the first side adjacent to the end; a cylindrical wall arranged about an end portion of the return tube to define an aperture and create a seal between the return tube and one side of the filter; and a hole extending between the first and second sides.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 5, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended Claim 1 discloses that the first wall is unbounded by the second

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wall. Amended Claim 5 discloses the diverter extending along a longitudinal axis and the first wall offset radially from the longitudinal axis. Amended Claim 10 discloses the hole outside of the second wall. The original disclosure is a side wall arranged opposite the cylindrical wall on the first side; a diverter arranged within the cavity and including first and second sides with the first side adjacent to the end; a cylindrical wall arranged about an end portion of the return tube to define an aperture and create a seal between the return tube and one side of the filter; and a hole extending between the first and second sides.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgekins, U.S. Patent No. 6,248,236 B1 in view of Miller et al., U.S. Patent No. 6,045,693.

Regarding Claim 6, Hodgekins discloses a fluid filter assembly comprising: a housing (#12, 16) having an end and defining a cavity; a first tube (#22) supported by the end and in fluid communication with the cavity; a diverter arranged within the cavity and including first and second sides with the first side proximate to the end, the diverter including a first wall (#54) in the first side proximate to the first tube and in sealing engagement with the end, wherein the first wall defines an aperture (#52) with an edge of the first wall in sealing engagement with the end of the housing, wherein the diverter includes a first material (#50) and a second material secured to the first material, the second material defining at least a portion of the first side

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including the edge of the first wall (#54); and a filter media (#60) having a portion supported by the second side. However, Hodgekins does not disclose a central wall. Miller teaches a fluid filter assembly comprising a first material (#37) and a second material secured to the first material wherein the second material defines a central wall (Fig. 16, between #146) extending away from the first wall (#145). It would have been obvious to one of ordinary skill in the art to modify Hodgekins with the element of Miller in order to facilitate easier installation (Col. 1, Lines 5-10).

Regarding Claim 14, Hodgekins discloses a fluid filter diverter assembly comprising: first and second sides spaced from one another; a first material (#50) and a second material (#54, 56) supported on the first material, the second material defining at least a portion of the first side; and a filter media (#60) secured to the second side, the first side having a first wall (#54) defining an enclosed aperture with a hole (#52) extending from the enclosed aperture to the second side, and the second material defining at least a portion of the first wall (#54), wherein the second material defines a side wall (#56) spaced from the first wall. However, Hodgekins does not disclose a central wall. Miller teaches a fluid filter assembly comprising a first material (#37) and a second material secured to the first material wherein the second material defines a central wall (Fig. 16, between #146) extending away from the first wall (#145). It would have been obvious to one of ordinary skill in the art to modify Hodgekins with the element of Miller in order to facilitate easier installation (Col. 1, Lines 5-10).

Response to Arguments

6. Regarding Claims 6 and 14, Applicant's arguments filed on April 5, 2006 have been fully considered but they are not persuasive.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art to modify Hodgekins with the element of Miller in order to facilitate easier installation (Col. 1, Lines 5-10).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yoon-Young Kim whose telephone number is (571) 272-2240. The examiner can normally be reached on 8:30-4:30, Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YK
06/07/06


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